

VERSION WITH MARKINGS TO SHOW CHANGES MADE

1. (amended) A keyless deadbolt lock engaging apparatus for use with a conventional deadbolt assembly, the apparatus comprising:

an actuator means to engage the deadbolt assembly;

a [rotational means] rotatable ring assembled with and capable of rotating against one or bearing surfaces of a body, said rotatable ring capable of rotating from a first position in which the actuator means is in a deadbolt disengaged position to a second position in which the actuator means is in a deadbolt engaged position; and

a biasing means connected with said rotatable ring to return the [rotational means] rotatable ring from the second position to the first position while the actuator means remains in the deadbolt engaged position; said actuator means, rotatable ring, and body attached with said conventional deadbolt assembly.

9.(amended) The keyless deadbolt lock engaging apparatus of claim 1 wherein the [rotational means] rotatable ring has a radial finger; and [is a rotating ring]

said biasing means has a first end connected with said radial finger and a second end connected with said body.

10.(amended) A keyless deadbolt lock engaging apparatus for use with a conventional deadbolt lock assembly, the lock assembly having an axial actuator, the apparatus comprising:

a body having a center aperture through which the lock assembly is located, the lock assembly being secured to the body;

a locator ring to secure the apparatus to a door fitted with the conventional deadbolt lock assembly;

a radial actuator [means] to engage the deadbolt assembly, the radial actuator including an arm extension and a center aperture through which the deadbolt lock assembly axial actuator is located;

a [rotational] rotatable ring [means] capable of rotating from a first position in which the

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actuator means is in a deadbolt disengaged position to a second position in which the actuator means is in a deadbolt engaged position; and

a biasing means connected with said rotatable ring to return the [rotational] rotatable ring [means] from the second position to the first position while the radial actuator [means] remains in the deadbolt engaged position.

16.(amended) A keyless deadbolt lock engaging apparatus for use in combination with a conventional deadbolt lock tumbler assembly having an axial actuator, the apparatus comprising;

a locator ring to secure the apparatus to a door to be fitted with the conventional deadbolt lock assembly;

a body to substantially house the lock assembly;

a rotatable ring, the rotatable ring including a radial finger;

a return spring mechanism connected with said radial finger of said rotatable ring; and

a radial actuator having a projecting arm, the arm being located adjacent to and moveable by the rotatable ring radial finger, the radial actuator further including a center aperture through which the lock tumbler axial actuator is located;

whereby upon turning the rotatable ring from a first position to a second position the radial finger pushes the radial actuator from a deadbolt disengaged position to a deadbolt engaged position, and further whereby upon release of the rotatable ring the return spring mechanism causes the rotatable ring to rotate back to the first position while allowing the radial actuator to remain in the deadbolt engaged position.

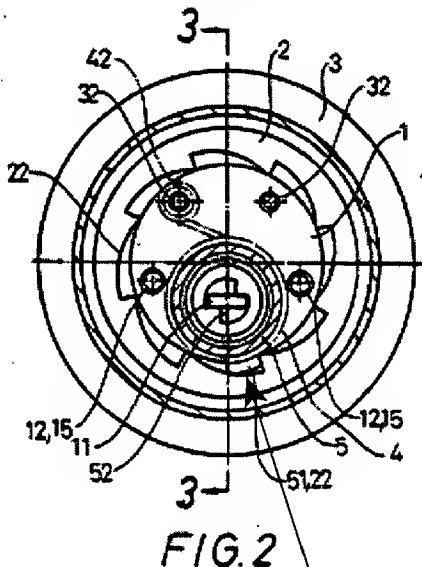
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REMARKS

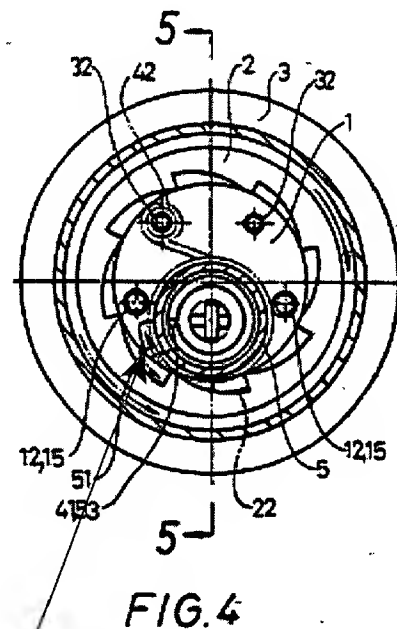
Claims 1, 9, 10, and 16 have been amended and together with the dependent claims therefrom are now, believed to comply with the requirements of 35 U.S.C. §§ 102 and 103. Applicant hereby certifies that the amendments herein presented do not introduce new subject matter into the application. A terminal disclaimer is included herewith, as requested by the Examiner.

In the Office action dated October 21st, 2002, the Examiner rejected claims 1, 2, 5, 6, 7, 9, 10, 11, 14, 15, and 16 under 35 U.S.C. § 102(b) as anticipated by *Lin*, U.S. #5,186,030 and claims 3, 4, 8, 12, and 13 under 35 U.S.C. § 103(a) as obvious in light of *Lin*. Applicant respectfully traverses the aforementioned § 102(b) and § 103(a) rejections as relating to Applicant's current amended claims and the dependants therefrom. Applicant further states that the remarks presented in Applicant's "Amendment A" dated March 18, 2002 are relevant to Applicant's amended claims and are hereby incorporated by reference.

Regarding the § 102(b) rejection of claims 1, 2, 5, 6, 7, 9, 10, 11, 14, 15, and 16, *Lin* claims and describes an actuating wheel 5 which has a torsional coil spring 4 attached thereto and not attached to *Lin*'s rotatable ring 2. This means that *Lin*'s rotatable ring 2 does not have a direct spring bias. Without a direct spring bias, *Lin*'s rotatable ring 2 cannot retract to a first position when rotated 90 degrees since the ratchet teeth 22 which actuated the tooth 51 of the actuating wheel 5, travel past the tooth 51. The actuating wheel 5 of *Lin* the retracts back to seat upon another ratchet teeth 22. The figures below (Figs. 2 & 4 of *Lin*) attempt to show this phenomena.



Lin's tooth is engaged by the ratchet teeth only when initially rotated. Thereafter the tooth separates from the ratchet teeth. No spring bias is placed upon the rotatable ring.



90 degree rotation for locking allows the rotatable ring of *Lin* to rotate past *Lin*'s tooth and not return to the ring's first position.

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Lin discloses the aforementioned limitation in col. 2, lines 53-54 when *Lin* admits that “the tooth 51 separates from one of the ratchet teeth 22” during clockwise rotation of the rotatable ring 2. In fact, once the deadbolt is locked in a clockwise direction, *Lin*’s rotatable ring 2 may move in a counterclockwise direction with no return bias spring effect on the ring 2. *Lin* admits of this in col. 2, lines 65-70 and col. 3, lines 1-4 when *Lin* states “if the rotatable ring 2 shown in FIG. 2 should be rotated 90° counterclockwise, the actuating wheel 5 can also rotate counterclockwise 90°, with the tooth 51 separating from one of the ratchet teeth 22 but not rotating the actuating plate 11, in other words, the actuating wheel 5 only rotates idle because of the empty space of the 8-shaped opening 52, unable to lock this lock.” Thus for *Lin*, only the actuating wheel 5 and not the rotatable ring 2 returns to a first position. Furthermore, said wheel 5 is not even assured of returning to the same first position since its returning position is dependent upon the location of the next set of ratchet teeth 22 when the wheel 5 rebounds. In contrast to *Lin*’s wheel 5, Applicant’s actuator means remains in the deadbolt engaged position and does not return to a first position as with *Lin*. This limitation is contained within the presently amended claims.

Lin’s actuator wheel 5 performs a similar function as Applicant’s radial actuator 62. That is, it moves or rotates the deadbolt lock axial actuator (20 for Applicant, 11 for *Lin*). *Lin*’s actuator wheel 5 is spring biased and Applicant’s is not. Applicant’s radial actuator 62 is not spring biased and does not rotate back once positioned, *Lin*’s actuator wheel 5 does rotate back to engage a different ratchet tooth 22.

Due to the aforementioned difference in operation, *Lin*’s rotatable ring 2 does not return to a first position. Applicant’s rotatable ring 52 as described in the presently amended claims has a direct biasing means which always returns it to a first position. Also, Applicant’s rotatable ring 52 design as described in the presently amended claims cannot freely rotate in a clockwise or counterclockwise direction as the *Lin* embodiment. The art of *Lin* allows for the rotatable ring 2 to move in either direction when the tooth 5 is rotated by the ratchet teeth 22 interior to the inner circle defined by the ratchet teeth 22. The only limitation on ring 2 movement in *Lin* is provided by the actuating plate 11 when it is locked by the lock 1 tumbler, if the lock 1 tumbler provides locking.

If the tooth 51 of *Lin* does not retract to an optimum position due to the dynamic positioning of the rotatable ring ratchet teeth 22, a constant spring bias force is kept upon the axial actuator (20 for Applicant, 11 for *Lin*) via *Lin*’s actuating wheel 5. This means that when unlocking the lock, *Lin* must rotate the key against the spring force of *Lin*’s coiled spring 4. This is exactly one of the problems which Applicant has successfully overcome. That is, since Applicant’s radial actuator 62 is not spring biased, Applicant need not apply extra or additional force to open the lock with a key.

As aforesaid, *Lin* relies upon the dead bolt lock 1 key tumbler itself to stop the deadbolt from being opened by the rotatable ring 2 once locked. (In col 2, lines 61-62 *Lin* states “but impossible to rotate ..the actuating plate 11 now stopped by the dead bolt”.) Since it is understood by those skilled in the art that some actuating plates (20 for Applicant, 11 for *Lin*) do not lock via the key tumbler but instead simply float and are only actuated by the key tumbler, the design of *Lin* is very limited as to what type of key lock tumbler may be utilized. Since Applicant does not allow his

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rotatable ring **52** to rotate freely and further does not provide any means for his radial actuator **62** to rotate from a locked position except for the key lock tumbler unlock said lock, Applicant may utilize his art with any type of deadbolt lock system. That is, as presently amended, Applicants actuator means remains in the deadbolt engaged position once moved and does not rely upon the key tumbler to lock the actuator means in a fixed position.

Under 35 U.S.C. §102, anticipation requires that each and every element of the claimed invention be disclosed in the prior art. In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. Akzo N.V. v. U.S. International Trade Commission, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987). *Lin's* specialty spring placed upon *Lin's* actuating wheel **5** which requires a return spring bias for proper operation and engages ratchet teeth **22** is not analogous to nor does it disclose Applicant's plurality of spring forms attached with Applicant's rotatable ring. Furthermore, Applicant's actuator means, whether radial actuator **62**, paddle actuator, or other form, does not require a spring bias to operate properly, *Lin* must have a spring bias on the device (actuating wheel **5**) which actuates the actuating plate **11** in order to function. Nowhere in *Lin* is reference made to use of the actuating wheel **5** without a spring bias, nor is disclosure provided to biasing the rotatable ring. Thus, the elements of Applicant's presently amended claims are not disclosed within *Lin*.

Further relating to *Lin*, invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference. There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Foundation v. Genentech Inc., 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991). The single prior art reference of *Lin* does not have all of the elements and limitations of Applicant's presently amended claims. As aforesaid, Applicants' invention as described in the amended claims differentiates Applicant's art from the elements and disclosure in *Lin*.

Regarding the §103(a) rejection of claims 3, 4, 8, 12, & 13 as obvious in light of *Lin*, applicant hereby incorporates by reference all remarks made regarding *Lin* as applied to the aforementioned §102 rejection. The design of *Lin* also requires a specifically shaped coiled spring **4** sized to fit around the actuating wheel **5** in order to actuate the actuating wheel **5** and ensure engagement with *Lin's* ratchet teeth **22**. (col 2, lines 7 - 10 of *Lin*) Applicant does not require such a strictly designed energy storage element. Nowhere in *Lin* is any suggestion made that a simple torsional, coiled constant force, coiled extension, or coiled compression spring will function. In fact said variations will not work with the art of *Lin*. Applicant's design purposely provides the versatility which allows more inexpensive off-the-shelf spring components to be utilized. *Lin* further requires a torsional coiled spring **4** having an upright end **41** and a looped end **42** and sized to fit over his actuating wheel **5**. Applicant purposefully requires no such specialty sizing or configuration.

Specifically regarding the spring selection, as aforementioned, *Lin* requires utilization of only one type of torsional coiled spring **4**. *Lin's* spring design must follow a specific form and shape and is not an off-the-shelf part. If the art of *Lin* could utilize a spring of various shapes or styles, *Lin* would have described such in his specification. Instead *Lin* chose to describe a specific type of spring

with a specialty size and ends which cannot be purchased off-the-shelf. *Lin* further chose to drive his actuating wheel 5 with the spring instead of driving the rotatable ring or making a suggestion to that effect.

Regarding the paddle actuator of Applicant's claim 8, *Lin* again utilizes an actuating wheel 5 with a tooth 51 which must be spring biased in order to function. Applicant's present art paddle actuator does not require a spring bias in order to function with Applicant's biased rotatable ring. No suggestion is made within *Lin* of using a paddle actuator without a spring bias. In fact, if *Lin* biased *Lin*'s rotatable ring 2 instead of *Lin*'s actuating wheel 5, the device could not function. No suggestion is made in *Lin* that biasing the rotatable ring 2 instead of *Lin*'s actuating wheel 5 is a reasonable alternative to the preferred embodiment of *Lin*. *Lin* relies upon the combination of a biased actuating wheel 5 and a freely rotating rotatable ring 2 in only that combination in order to function. *Lin* was free to suggest this alternative embodiment but failed to do so.

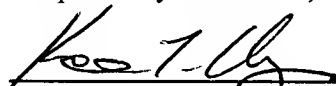
The Federal Circuit now uses the suggestion test to assess obviousness rejections. In the case of *In re Kotzab*, 55 USPQ2d 1313 (Fed. Cir. 2000), the Federal Circuit stated that "to establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." (the term "*specific*" is emphasized) *Lin*, alone or in combination with the other cited references, does not provide a motivation, suggestion, or teaching of the desirability of biasing the rotatable ring instead of the actuating wheel and in fact cannot since *Lin*'s device will not function in that form. In fact, *Lin* specifically ignores the advantages of utilizing off the shelf springs of various forms or utilization of a paddle actuator.

The aforesaid motivating suggestion must also be explicit. *Winner International Royalty Corp. v. Wang* 48 USPQ2d 1139, (D.C.D.C. 1998). The fact that prior art "may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 922 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Again, as aforesaid, *Lin* does not, and cannot, explicitly suggest the desirability of Applicant's art or the unique combination which Applicant has provided. If *Lin* did make such a suggestion, his device could not operate since *Lin* relies upon the unique combination of a spring actuated wheel 5 and a non spring biased rotatable ring 2 for proper function.

In view of the foregoing, the claims along with their corresponding dependent claims are herewith submitted as patentable. Accordingly, favorable reconsideration and allowance of this application is requested.

Pursuant to the Draftperson's request, formal drawings are included herewith.

Respectfully submitted,



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CERTIFICATE OF MAILING

I certify that the foregoing **AMENDMENT B** is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Box Non-Fee Amendment, Washington, D.C. 20231, on JANUARY 9, 2003.



Kevin L. Klug

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